

REMARKS

Reconsideration and withdrawal of the rejections set forth in the Final Office Action dated January 27, 2009, are respectfully requested in view of this amendment and the following reasons.

By this amendment, claims 1, 8, 9, 18 and 22 have been amended. Accordingly, claims 1-25 are pending in this application.

Claim 1, 8, 9, 18 and 22 have been amended to describe the printing cost information for at least one of the printing machines having a printing unit price that includes an initial material cost for a print order and an incremental per-page cost, so that the printing cost varies depending on a print count. Support is found in the specification, *inter alia*, at page 14, lines 6-14. The amendment to claim 9 effects a formatting change (at P_{ink}) It is submitted that the above amendments introduce no new matter within the meaning of 35 U.S.C. §132.

In the Final Office Action, claims 1-8, 10-13 and 15-25 were rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 6,516,157 issued to Maruta et al. (hereinafter *Maruta*) and claims 9 and 14 were rejected under 35 U.S.C. 103(a) as obvious over *Maruta*. Applicants request reconsideration and timely withdrawal of the pending rejections for the reasons discussed below.

Rejections Under 35 U.S.C. §102

Claims 1-8, 10-13, and 15-25 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by *Maruta*. *Maruta* is again cited as describing a cost information section for registering printing cost information for each of a plurality of printing machines. Printing cost is calculated for printing image data based on area coverage and print count.

Response

This rejection is traversed as follows. For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

The claims now describe

"... registering printing cost information for each of a plurality of printing machines connected via the electronic network, wherein the printing cost information for at least one of the printing machines has a printing unit price that includes an initial material cost for a print order and an incremental per-page cost, so that the printing cost varies depending on a print count ... calculating an area coverage by image forming material... calculating a printing cost ... based on the area coverage ... printing cost information for each of the plurality of printing machines including the initial material cost, and ... print count" (Claim 1; claims 8, 18 and 22 similar.)

Maruta fails to show or suggest including an initial material cost estimate within the pricing data. In the present application, the initial material cost can be significant. For instance, referring to Figs. 25 and 26, a stencil master could cost in the neighborhood of 30 Yen, whereas the incremental cost of a stenciled sheet could cost 1 Yen. The ability to incorporate these costs makes it possible to render cost comparisons, on an automatic basis, with electrostatic copying.

This is more than a trivial matter. As recognized by *Maruta*, but not resolved therein, there are different costs associated with items such as ink and toner (page 14, lines 6-8 and page 24, lines 1-4). In the case of complex print jobs, the particular output device can make a significant difference in cost. There is nothing in the cited *Maruta* reference that accommodates this type of non-linear variation between machine types. In addition, there is no suggestion or teaching of an initial cost being included in any of *Maruta's* calculations.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §102(b) rejection of claims 1-8, 10-13, and 15-25. Claims 9 and 14 depend from claim 8, and are allowable for at least this reason. Since none of the other prior art of record discloses or suggests all the features of the claimed subject matter, Applicants respectfully submit that independent claims 1, 8, 18, and 22, and all the claims that depend therefrom, are allowable.

Rejections Under 35 U.S.C. §103

Claims 9 and 14 stand rejected under 35 U.S.C. §103(a) as being allegedly obvious over *Maruta*. The rejection alleges that the use of a particular algorithm, calculation, expression, equations or formula to calculate costs is known.

Response

This rejection is traversed as follows. To establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

A *prima facie* case of obviousness must also include a showing of the reasons why it would be obvious to modify the references to produce the present invention. *See Dystar Textilfarben GMBH v. C. H. Patrick*, 464 F.3d 1356 (Fed. Cir. 2006). The Examiner bears the initial burden to provide some convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings. *Id.* at 1366.

Applicants respectfully submit that claims 9 and 14 are allowable over *Maruta* at least because they depend from allowable claim 8.

Regarding the use of a particular formula, there is no suggestion that such a formula be incorporated into *Maruta*. To the contrary, *Maruta* specifies cost calculation according to a cost schedule which linearly applies cost based on area and ink, but without accounting for initial material costs. Accordingly, there is no suggestion that one would accommodate the use of a stencil master into a cost calculation. Instead, a cost according to *Maruta* would presume the stencil machine produces the most economical print output. This would of course be the case even for single copy print jobs, except that there is an initial cost outlay in producing stencil masters. Therefore, an application of *Maruta* contradicts the present subject matter as presented in claims 9 and 14.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 9 and 14.

Examiner's Response to Applicants' Prior Arguments

The Examiner's acknowledgement of Applicants' arguments with respect to the cited art is noted. It is respectfully pointed out that the basis for Applicants' arguments still remains in view of the new grounds for rejection, under the newly-cited art. Accordingly, Applicants refer again to these arguments with respect to the current rejections.

CONCLUSION

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submit that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

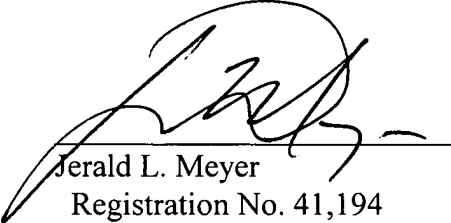
Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,
THE NATH LAW GROUP

April 6, 2009

THE NATH LAW GROUP
112 South West Street
Alexandria, VA 22314-2891
Tel: 703-548-6284
Fax: 703-683-8396



Gerald L. Meyer
Registration No. 41,194
Derek Richmond
Registration No. 45,771
Stanley N. Protigal
Registration No. 28,657
Customer No. 20529